

Notice of Allowability

Application No.

09/416,902

Examiner

Amber D. Steele

Applicant(s)

MCCAFFERTY ET AL.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to November 16, 2007.
2. ☒ The allowed claim(s) is/are 44,47,48,61 and 62.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/971,857.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>20080129</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

/Jon D. Epperson/
Primary Examiner, AU 1639

ALLOWANCE

1. Applicants' response received on November 16, 2007 is acknowledged and entered.

Status of the Claims

2. Claims 44, 47-48, and 53-62 are currently pending and under consideration.

Examiner's Amendment

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with David Clough on January 29, 2008.

4. The application has been amended as follows:

- A. Claim 44 is rewritten as follows:

--"A method of obtaining a member of a specific binding pair, the method comprising: providing a library of in vitro mutagenized nucleic acids from an existing antibody coding sequence, producing a library of filamentous bacteriophage particles displaying on the surface a population of specific binding pair members which comprise a binding domain of an immunoglobulin, each particle containing a nucleic acid sequence from the library of in vitro mutagenized nucleic acids from an existing antibody coding

sequence, contacting the library of filamentous bacteriophage particles with a desired epitope, and separating particles displaying on the surface specific binding pair members comprising a binding domain which binds to said epitope, wherein the specific binding pair members are Fabs.”--

B. Claims **53, 54, 55, 56, 57, 58, 59, and 60** are **canceled**.

The claims are canceled because they are drawn to inventions nonelected without traverse in the response received on March 15, 2004 (see MPEP § 1302.04(c) and § 821.02).

Withdrawn Rejection

5. The rejection of claims 44, 47, 48, 61, and 62 under 35 U.S.C. 103(a) as being unpatentable over Huse et al. Science 246(4935): 1275-1281, 1989 and Dower et al. U.S. Patent 5,427,908 filed May 1, 1990 is withdrawn in view of the claim amendment above (i.e. examiner’s amendment; “displaying on the surface”).

Reasons for Allowance

6. The following is an examiner’s statement of reasons for allowance:

The instant claims are allowed for the primary reason that the instant claimed method of obtaining a member of a specific binding pair via producing a library of filamentous bacteriophage particles displaying on the surface a population of Fabs is free of the prior art primarily because surface displaying an Fab on filamentous bacteriophage is free of the prior art. The prior art recognized unpredictability and skepticism in surface

displaying peptides on filamentous phage that were longer than 300 amino acids in length.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Future Communications

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber D. Steele whose telephone number is 571-272-5538. The examiner can normally be reached on Monday through Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ADS
January 29, 2008

/Jon D. Epperson/
Primary Examiner, AU 1639